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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,206	01/25/2002	Robert J. Small	M-12178 US	1702
9629	7590	09/13/2007		
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			EXAMINER MARCHESCHI, MICHAEL A	
			ART UNIT	PAPER NUMBER
			1755	
			MAIL DATE	DELIVERY MODE
			09/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/057,206	SMALL ET AL.	
	Examiner	Art Unit	
	Michael A. Marcheschi	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 77-106 and 108-139 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 77-106, 108-120 and 125-137 is/are rejected.
- 7) ☒ Claim(s) 121-124, 138 and 139 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

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Applicants are reminded that claim 101 is defined as “10” (see page 5 of the claims listing).

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 135-137 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 135, 136 and 137 are indefinite as to the limitation “first abrasive” because this lacks antecedent basis since claim 112 does not define a “first abrasive”.

Claims 77-82, 86-106, 108, 109, 111-114, 116-120, 125-130 and 132-136 are rejected under 35 U.S.C. 103(a) as obvious over Wang et al. (184).

Wang et al. (184) in the abstract and sections [0014], [0016], [0017], [0024], [0033] and [0034], a polishing composition for polishing a substrate comprising a noble metal layer and a dielectric layer (i.e. composition in contact with a noble metal substrate), said composition comprises an abrasive (alumina) and periodates and acids thereof (i.e. this is periodic acid). It is shown that a combination of abrasives can be used thus reading on the claimed suspension agent (i.e. another abrasive). The amounts for the abrasive and periodic acid are defined. Other components can be added (i.e. organic acid (succinic acid), surfactant, pH adjustor (sodium

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hydroxide, etc.), etc.). Section [0028] shows that the pH of one type of the system is 6.5. The examples provide other pH values.

Wang et al. teaches amounts for the periodic acid and it is the examiners position that when said amounts are calculated in terms of moles/kg, said amounts will encompass the claimed amounts. If applicants wish to argue the claimed amounts, burden is upon applicants to show the contrary to the above statement (i.e. show that the reference range is not within the range of the claimed amounts). This reference also defines amounts for the components and it is the examiners position that the combined amounts defined by the reference will render a substrate substantially planar, thus making this limitation obvious. In view of this, no patentable distinction is seen to exist between the reference composition and the claimed composition in the absence of any evidence showing the contrary. With respect to the characteristics (i.e. polishing rate, selectivity and characteristics of claims 92, 93, and 108), since the composition is the same and is used to polish the same substrate, these characteristics are expected and therefore obvious because the same polishing composition is expected to provide the same polishing characteristics to a substrate upon polishing absent clear evidence showing the contrary. In view of this, the limitations of claims 77-82, 86-106, 108, 109, 111-114, 116-120, 126-128, 130 and 132-134 are met

With respect to claim 125, the primary reference teaches that the abrasive can be a mixture of alumina and silica and this broadly encompasses any type of silica, including colloidal silica, thus the composition can contain all of the claimed components, irrespective of the purpose of said components.

With respect to claim 129, the reference states that mixtures of abrasives can be used.

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With respect to claims 135-136, the primary reference teaches that alumina can be used and it is the examiners position that this reads on any alumina form absent critical evidence.

With respect to claims 112-114, 116-120, 125-130 and 132-136, the combination as defined above teaches the claimed invention. Although "consisting essentially of" is used and Wang et al. might use additional components, no distinction is seen to exist because it is the examiners position that these components will not materially effect the basic and novel properties of the composition and thus are still within the scope of the claims. Burden is upon applicants to show that this additional component will materially affect the basic and novel properties of the claimed composition.

Claims 110 and 131 are rejected under 35 U.S.C. 103(a) as obvious over Wang et al. (184) as applied to claim 112 above and further in view of Beitel et al. (208).

Beitel et al. teaches in section [0013] that substrates based on an iridium oxide layer (and a silicon dioxide layer (dielectric)) are known to be polished with an abrasive polishing slurry.

With respect to the specific substrate (iridium oxide), Wang et al. implies that the substrate can be any suitable substrate. This suggests to the skilled artisan that any known substrate can be polished and thus the polishing of a substrate comprising iridium oxide would have been obvious to the skilled artisan because this type of substrate is known to be polished with an abrasive polishing slurry, as shown by Beitel et al. The motivation for this combination is defined by Wang et al. in the implied statement that states any suitable substrate can be polished.

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Claim 137 is rejected under 35 U.S.C. 103(a) as obvious over Wang et al. (184) as applied to claim 112 above and further in view of Lack et al. (264).

Lack et al. teaches in section [0052] that a mixture of alpha alumina and gamma alumina is a known abrasive for polishing compositions.

With respect to claim 137, the use of a mixture of alpha alumina and gamma alumina is obvious to the skilled artisan because this mixture is notoriously known to be used as the abrasive in polishing composition, as shown by Lack et al. and Wang et al. implies that any suitable abrasive known in the art may be used. Although Lack et al. is not directed to polishing noble metals, the concept of using two different alumina forms is known, irrespective of what it is used to polish.

Claims 83-85 and 115 are rejected under 35 U.S.C. 103(a) as obvious over Wang et al. (184) as applied to claims 77 and 114 above and further in view of Sachan et al. (027).

Sachan et al. teaches in claim 1 and section [0025] that polishing compositions for polishing noble metals are known to have a pH of 1.5-5.

Although Wang et al. does not literally define the pH for the broad composition (i.e. any and all compositions for polishing noble metals within the scope of the reference), the use of the claimed pH in the composition of Wang et al. would have been obvious because in polishing compositions, the pH of the composition is dependent on the substrate to be polished, and as is shown by Sachan et al., when the substrate to be polished is a noble metal, the pH of the composition is defined as 1.5-5. In view of this, one skilled in the art would have appreciated the pH values required for polishing a noble metals according to Sachan et al.

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Applicant's arguments with respect to all the claims have been considered but are moot in view of the new ground(s) of rejection.

The declaration filed on 6/28/07 under 37 CFR 1.131 is sufficient to overcome the Moeggenborg et al. (100) reference. In view of this, the previous rejections are withdrawn.

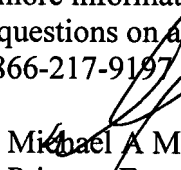
Claims 121-124 and 138-139 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

7/07
MM


Michael A. Marcheschi
Primary Examiner
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